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10/806,643	03/23/2004	Jeffrey J. Schroeder	35691US1	2569
116 7590 03/26/2009 PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108				
EXAMINER				
VO, HAI				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JEFFREY J. SCHROEDER, BRADLEY D. MCDONEL,  
and SCOTT A. CHURBY

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Appeal 2009-1675  
Application 10/806,643  
Technology Center 1700

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Decided:<sup>1</sup> March 26, 2009

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Before EDWARD C. KIMLIN, ADRIENE LEPIANE HANLON, and  
JEFFREY T. SMITH, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 2, 3, 5, 7, 10-12, 15

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the Decided Date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

-23, 33, 35, 39-42, 44, 45, and 47-49. We have jurisdiction under 35 U.S.C. § 6(b).

Claim 47 is illustrative:

47. A combination comprising an automobile body panel having a heat shield fastened or mounted to said body panel, said heat shield comprising a first metallic outer layer, a second metallic outer layer, and a foam layer disposed in between said first and second metallic outer layers, said foam layer being deformable to accommodate a particular shape and contour to which the heat shield is to be bent and to generally conform in use without substantially damaging the cellular structure of the foam as a result of such deformation, said foam layer being effective to withstand operative heat shield temperatures of at least 1000°F, and to dampen acoustic tonal frequencies below 2000 Hz.

The Examiner relies upon the following references in the rejection of the appealed claims (Ans. 2-3):

Hasegawa	4,923,904	May 8, 1990
Zwick	6,302,466 B1	Oct. 16, 2001
Poole	6,955,845 B1	Oct. 18, 2005
Ragland	WO 90/14944	Dec. 13, 1990

Appellants' claimed invention is directed to a heat shield mounted to an automobile body panel. The heat shield comprises first and second metallic outer layers and a foam layer dispersed therebetween. The foam layer is able to withstand temperatures of at least 1000°F and can dampen acoustic tonal frequencies below 2000 Hz.

Appealed claims 3, 7, 10-12, 33, 35, 39, 42, 45 and 47-49 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Zwick. Claims 2, 3, 5, 7, 10-12, 19, 20, 33, 35, 39-42, 44, and 47-49 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as

being unpatentable over Ragland. The appealed claims also stand rejected under 35 U.S.C. § 103(a) as follows:

- (a) claims 21-23 over Zwick in view of Hasegawa,
- (b) claims 21-23 over Ragland in view of Hasegawa,
- (c) claims 15-18 over Ragland in view of Poole,
- (d) claims 2, 3, 5, 7, 10-12, 15-20, 33, 35, 39-42, 44, and 47-49 over Poole in view of Ragland, and
- (e) claims 21-23 over Poole in view of Ragland and Hasegawa.

We have thoroughly reviewed the respective positions advanced by Appellants and the Examiner. In so doing, we find that the Examiner's rejections are not supported by the applied prior art. Accordingly, we will not sustain the Examiner's rejections.

The basis for all of the Examiner's rejections is that Zwick and Ragland disclose a combination of a heat shield mounted on an automobile body panel wherein the heat shield comprises first and second metallic outer layers and a foam inner layer that inherently has the presently claimed properties. Although both Zwick and Ragland are silent with respect to heat and sound insulation values for the disclosed foam inner layer, the Examiner finds that the foam layers of the references inherently possess such properties since they are described as having good or excellent heat and sound insulation qualities.

We agree with the Examiner that it is reasonable to conclude that the resilient foams of Zwick and Ragland possess the claimed property of generally conforming to a particular shape and contour without substantially damaging the cellular structure of the foam. However, we concur with Appellants that the Examiner has not made out the prima facie case that the

foams of Zwick and Ragland necessarily or inherently possess the claimed combination of heat and sound insulation values. The Examiner has not met the burden of establishing a reasonable correspondence between foam compositions disclosed by the references and those disclosed in the present Specification to justify the finding that the prior art foam compositions inherently possess the same properties as Appellants' foam composition. Nor has the Examiner demonstrated with compelling reasoning or objective evidence that it was known in the art of automotive heat and sound insulation to use foams that are effective to withstand operative heat shield temperatures of at least 1000°F and to dampen acoustic tonal frequencies below 2000 Hz. Hence, the Examiner's position lacks the requisite factual support that the foams generally disclosed by Zwick and the polyurethane foams disclosed by Ragland inherently possess the claimed values for heat and sound insulation. The other prior art references cited by the Examiner do not remedy the basic deficiency of Zwick and Ragland.

In conclusion, based on the foregoing, we are constrained to reverse the Examiner's rejections.

REVERSED

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